UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C.
Petitioner,

v.

MULTIMEDIA CONTENT MANAGEMENT LLC
Patent Owner.

IPR NO.: 2019-01015
ATTORNEY DOCKET NO.: 081841.0120

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

I. INTRODUCTION

After the Petition in this matter was filed, the Board designated its decision in *NHK Spring* as precedential, and the District Court in the parallel proceeding construed the claims, denied a motion to stay, and set a trial date. Patent Owner relied on these intervening developments in its Preliminary Response. *See* Preliminary Response ("POPR") at 5-11. By email, the Board granted Petitioner's request to file a reply addressing whether these circumstances warrant denial of institution. They do not.

II. ARGUMENT

A. The Parallel District Court Proceeding Does Not Provide a Basis for Denying Institution Under *NHK Spring*

As an initial matter, the Preliminary Response incorrectly suggests that Petitioner delayed filing the Petition and caused a duplication of resources with the parallel District Court proceeding. To the contrary, the parties mutually agreed to delay all discovery until an early mediation occurred on April 17, 2019 and, once the mediation ended unsuccessfully, the Petition was filed less than a week later. The Petition was filed just before Markman occurred, before fact discovery opened, and before a trial date was set. In fact, the District Court did not set a trial date until well after the filing of the Petition. These are not circumstances that warrant a denial of institution.

In an attempt to analogize this case to *NHK Spring*, Petitioner incorrectly

contends that the invalidity grounds in the instant Petition completely overlap with the District Court proceeding. *See* POPR at 6 ("[E]ach of the issues raised in the Petition … will be decided by the District Court."); *NHK Spring Co. v. Inti-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19, 20 (PTAB Sept. 12, 2018). While that was the situation in *NHK Spring*, it is not true here.

First, unlike the key fact in *NHK Spring*, Petitioner does not intend to rely on the same invalidity grounds in the parallel District Court proceeding if the Petition is instituted. Patent Owner here merely speculates the invalidity grounds will be the same. *See* POPR at 9 ("***Assuming*** that Petitioner has presented its best arguments for invalidity in its Petition, Patent Owner ***expects*** that the District Court will rule on the same grounds.") (emphasis added). However, invalidity contentions are not due until September 13, 2019, and ***if the Petition is instituted, Petitioner will not rely on the grounds raised in the Petition***. The Board has distinguished *NHK Spring* where, as here, there is not a substantial overlap of the invalidity issues because the asserted prior art in each proceeding is "substantially different." *Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, IPR2019-00237, Paper 15 at 11-12 (PTAB July 5, 2019).

Second, most of the claims challenged in the Petition will not be decided in the district court proceeding, whereas there was complete overlap in *NHK Spring*. Specifically, the Petition here challenges fifteen claims, but Patent Owner must

reduce the number of asserted claims to just six by December 1, 2019, thereby leaving at least nine claims challenged in the Petition that will not be decided in the District Court proceeding. *See* EX2009 (Scheduling order). This fact also supports institution, as the Board has previously found. *See* IPR2019-00237, Paper 15 at 12.

Also, *NHK Spring* was "decided chiefly on § 325(d)" and is distinguishable where, as here, § 325(d) "is not an independent reason for denial." *Samsung Elecs. Co. v. Immersion Corp.*, IPR2018-01502, Paper 11 at 35-36 (PTAB Mar. 29, 2018); *see also Intel Corp. v. Qualcomm Inc.*, IPR2019-00128, Paper 9 (PTAB May 29, 2019) ("[T]he panel in *NHK Spring* chose to deny institution based on factors independent from its consideration of the parallel district court proceeding."). The Board in *NHK Spring* found that all six factors under § 325(d) weighed in favor of denying institution, noting "importantly" that "the asserted art is a subset of the same prior art that the Examiner applied … [and] the arguments Petitioner advances in its Petition are substantially similar to the findings the Examiner made." IPR2018-00752, Paper 8 at 18. Those facts are not present here, where the Petition presents new art and arguments.

B. The District Court's Construction of "Selectively Transmit" Does Not Impact the Petition's Demonstration of Success on the Merits

Petitioner has not proposed inconsistent claim constructions in the Petition and the District Court, nor was that Court's construction at odds with the constructions in the Petition. During claim construction, the District Court ordered

construction of six terms. For the construction of the "selectively transmit" term, the District Court adopted a construction that is consistent with and nearly identical to the Petitioner's construction as shown below.

Petition Construction	District Court Construction
"transmitting all content requests ***to take place within*** the service provider network in response to the controller instructions' decision to transmit the content requests"	"transmitting all ***selected*** content requests ***through*** the service provider network in response to the controller instructions' decision to transmit the content requests"

Patent Owner first assumes the District Court's construction is correct without explaining why that construction is better than Petitioner's proposed construction. Patent Owner then argues that the two small differences between the constructions (in bold italics above) means that the Petition is fatally "keyed" to an improper construction. POPR at 11. To make this flawed argument, Patent Owner ignores that the two constructions are virtually the same. As the claim itself makes clear, a decision is made to transmit certain (*i.e.* selected) content requests and then, in a later step, all such content requests are "transmitted" ***"in response to the controller instructions' decision to transmit***" them. Patent Owner drops the later portion of the construction in order to argue that the prior art only teaches "all content requests—rather than only all selected content requests—are transmitted" (POPR at 11). But, the Petition fully explains how the "selected" element is met.

The Petition states, for example, that "[t]he transmission of content requests … is '***selective***' because the check at step 704 determines whether the STB

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